

REMARKS

Claims 1-52 are pending; of these, claims 5-14, 29 and 31-43 are withdrawn from consideration as being drawn to a non-elected species. Therefore, claims 1-4, 15-28, 30 and 44-52 are under consideration. All stand rejected. The applicants request further consideration and re-examination in view of the amendments above and remarks set forth below.

Information Disclosure Statement:

In the office action mailed on May 28, 2004, the Information Disclosure Statement (IDS) submitted on Nov. 8, 2000, was indicated as failing to comply with 37 CFR 1.98(a)(2) because a copy of reference AG by Malluhi, et al. was not supplied with the statement. With the applicants' response filed on October 28, 2004, the applicants submitted a supplemental IDS, together with a copy of the Malluhi, et al. reference and the fee under 37 CFR 1.17(p). The office action mailed on May 2, 2005, acknowledges the applicants' response to the IDS objection. However, the office action does not appear to have an attached copy of the October 28, 2004, IDS with the examiner's initials showing that the Malluhi, et al. reference was considered. Therefore, the applicants respectfully request that the Malluhi, et al. reference be considered and that the examiner's consideration of the Malluhi, et al. reference be made of record in the application file.

Rejections under 35 U.S.C. § 112:

Claims 46 and 47 are rejected under 35 U.S.C. § 112 on the grounds that the terms "may" and "may be" render the claims indefinite. Claims 46 and 47 are amended to no longer use these terms.

Claims 18 and 50 are rejected under 35 U.S.C. § 112 on the grounds that the phrase "that is not controlled" is a "negative limitation." The examiner cites *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953) in support of the rejection.

The applicants respectfully traverse the rejection. Regarding "negative limitations," the Manual of Patent Examining Procedure (M.P.E.P.) states the following:

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely,

albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

M.P.E.P. at Section 2173.05(i), (8<sup>th</sup> Ed. Rev. 2). Thus, the M.P.E.P. is clearly contrasting *In re Schechter*, upon which the examiner relies, with the "current view of the courts" which is that "there is nothing inherently ambiguous or uncertain about a negative limitation." Note that *In re Schechter* is referenced by the M.P.E.P. as being exemplary of "[s]ome older cases" which are contrasted with the current view as exemplified by *In re Wakefield* and *In re Barr*.

The applicants' claim 18 recites:

The method of claim 16, wherein the block is selected using a protocol to produce a number that corresponds to the selected block and that is not controlled by any one backup partner individually.

Similarly, the applicants' claim 50 recites:

The method according to claim 49, wherein the verifying includes selecting a block of the previously backed up data wherein the selecting is not controlled by any one of the computers individually.

The applicants submit that these claims are not indefinite because the boundaries of patent protection sought are set forth definitely. As explained above by the M.P.E.P., the mere presence of a "negative limitation" does not render a claim indefinite.

In view of the above, the applicants respectfully request that the rejections under 35 U.S.C. § 112 be removed.

Rejections under 35 U.S.C. § 103:

Claims 1-4, 15, 44, 45, 48, 49 and 51-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bell et al. (US 2002/0049778) in view of Nemovicher (US 2002/0007453). Particularly, the examiner stated that Bell is silent on reciprocal backup, but that Nemovicher discloses utilizing reciprocal backup among computer nodes in Fig. 5 and paras. 69-70. Claims 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bell et al. and Nemovicher, as applied to claim 1 and further in view of “what is well known in the art.”

The applicants respectfully traverse the rejection on the grounds that Nemovicher does not constitute prior art. In order to properly apply a reference under 35 U.S.C. § 103, the reference must first be qualified as prior art under 35 U.S.C. § 102. The applicants’ filed their application on Sept. 22, 2000.<sup>1</sup> Nemovicher was published on January 17, 2002, which was after the applicants’ filing date. Therefore, Nemovicher can only qualify as prior art under 35 U.S.C. 102(e), if at all.

Moreover, Nemovicher was filed on May 22, 2001, claiming priority of U.S. Provisional Application No. 60/206,580, filed on May 23, 2000. U.S. Provisional Application No. 60/206,580 is identified on the attached Information Disclosure Statement. Because the May 22, 2001, filing date of Nemovicher is after the applicants’ September 22, 2000, filing date, Nemovicher can only qualify as prior art under 35 U.S.C. § 102(e) if U.S. Provisional Application No. 60/206,580 properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112. See also M.P.E.P. at Section 2136.03. Because the examiner has not shown that the subject matter relied upon to make the rejection is properly disclosed in U.S. Provisional Application No. 60/206,580, the examiner has not made a *prima facie* case for obviousness. See, M.P.E.P. at Section 2142 (8<sup>th</sup> Ed. Rev. 2)(discussing the legal concept of *prima facie* obviousness and explaining that if an examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness). For at least this reason, the applicants respectfully request that the rejection be removed.

Moreover, the applicants have studied U.S. Provisional Application No. 60/206,580, and are unable to identify any disclosure of the subject matter upon

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<sup>1</sup> The applicants claim priority of a provisional application filed on June 2, 2000. However, the filing date of the provisional application need not be relied upon in order to overcome the rejection.

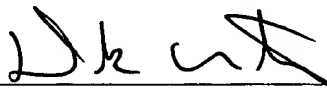
which the rejection is based (namely, the use of reciprocal backup among computer nodes). Therefore, U.S. Provisional Application No. 60/206,580 does not disclose this subject matter in compliance with 35 U.S.C. § 112. Accordingly, Nemovicher is not available as prior art and cannot be applied under 35 U.S.C. § 103. In view of this, the applicants respectfully request that the rejection be removed.

Conclusion:

In view of the above, the applicants submit that all of the claims under consideration are now allowable. Allowance at an early date would be greatly appreciated. Should any outstanding issues remain, the examiner is encouraged to contact the undersigned at (408) 293-9000 so that any such issues can be expeditiously resolved.

Respectfully Submitted,

Dated: July 1, 2005

  
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Derek J. Westberg (Reg. No. 40,872)